



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,003	07/10/2000	HAJIME INOUE	SONYJP-086	6725
530 7590 06/17/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER ALAM, MUSHFIKH I				
ART UNIT		PAPER NUMBER		
2426				
MAIL DATE		DELIVERY MODE		
06/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/600,003

Applicant(s)

INOUE ET AL.

Examiner

MUSHFIKH ALAM

Art Unit

2426

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52, 58-67 and 72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52, 58-67 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date 12/8/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 52, 58-67, 72 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/21/2009 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 52, 58-67 and 72 are rejected under 35 U.S.C. 103(a) as being obvious over Akamatsu et al. (US 7224886) and Sparks et al. (US 2002/0018638), and further in further view of Hashimoto et al. (US 5990940), and further in view of Yuen (US 5621579).

As to claim 52, Akamatsu discloses a receiving apparatus of a digital broadcasting for

receiving a digital broadcasting signal constructed by a transport stream in which video data and audio data have been compressed and multiplexed, comprising (see Akamatsu, fig. 1, the IRD represents a receiving app for a digital broadcast):

a decoder for decoding said received digital broadcasting signal (see Akamatsu, fig. 1, the IRD is a decoder of the signal);

a digital interface for receiving a transport stream from an external reproducing apparatus (fig. 1, recording device) having both analog and digital recording and reproducing modes (see Akamatsu, fig. 4, *the communication interface is a digital interface with an external reproducing apparatus with D/A record and play modes (see p. 21, ll. 20-25 and fig. 4 shows both a reproducing and recording section on the related device)*); and

Akamatsu is unclear on the digital broadcast signal is displayed; however, Sparks, who discloses OSD insertion, does teach the digital broadcast signal being displayed (see Sparks [0008] a dig. Signal source is coupled to display regardless of recorder's status). Sparks teaches a display processing circuit for displaying (see Sparks, fig. 2, processing within 200).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Akamatsu with the apparatus of Sparks in order to allow for display of digital signals during digital record mode without adding extra complexity to the apparatus.

The combined teaching is unclear on the displaying of an alarm or message if the user selects an input/output that is inconsistent with the mode of the recorder/reproducer (and therefore could not be decoded).

However, it is submitted that it would have been clearly obvious (as evidenced by Hashimoto col. 11, ll. 17-35 and fig. 14a) to one of ordinary skill in the art at the time the invention was made to modify Akamatsu and Sparks with the displaying of an alarm if an input or output that is inconsistent with the replay mode so as to notify the user of a problem that may arise in program recording or reproduction.

Akamatsu, Sparks are unclear on the specific features of
“a CPU programmed for retrieving information associated with a program recorded on a recording medium loaded in said reproducing apparatus from a memory in said reproducing apparatus” and

“a decoding capability circuit for determining whether a digital signal of the program recorded on the recording medium reproduced by said reproducing apparatus and received through said digital interface is decodable by said decoder.”

However, Yuen discloses a CPU programmed for retrieving information associated (titles) with a program recorded (figs. 18-19) on a recording medium loaded in said reproducing apparatus from a memory in said reproducing apparatus (see figs 18-19 for a list of recorded programs).

Yuen also inherently discloses the ability to determine whether a digital signal of the program recorded on the recording medium reproduced by said reproducing apparatus and received through said digital interface is decodable by said decoder. *If*

the program is displayed on the display apparatus then it has been determined that the program is indeed decodable.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a list of recorded programs as taught by Yuen '579 to the system of Akamatsu, Sparks, Hashimoto to allow users to locate and view recorded programs (col. 16-17, lines 65-06).

As to claim 58, Akamatsu discloses a receiving apparatus of a digital broadcasting for

receiving a digital broadcasting signal constructed by a transport stream in which video data and audio data have been compressed and multiplexed, comprising (see Akamatsu, fig. 1, the IRD represents a receiving app for a digital broadcast):

a decoder for decoding said received digital broadcasting signal (see Akamatsu, fig. 1, the IRD is a decoder of the signal);

a digital interface for receiving a transport stream from an external reproducing apparatus (fig. 1, recording device) having both analog and digital recording and reproducing modes (see Akamatsu, fig. 4, the communication interface is a digital interface with an external reproducing apparatus with D/A record and play modes (see p. 21, ll. 20-25 and fig. 4 shows both a reproducing and recording section on the related device); and

Akamatsu is unclear on the digital broadcast signal is displayed; however, Sparks, who discloses OSD insertion, does teach this (see Sparks [0008] a dig. Signal

source is coupled to display regardless of recorder's status). Sparks teaches a display processing circuit for displaying (see Sparks, fig. 2, processing within 200).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Akamatsu with the apparatus of Sparks in order to allow for display of digital signals during digital record mode without adding extra complexity to the apparatus.

Akamatsu, Sparks are unclear on the displaying of an alarm or message if the user selects an input/output that is inconsistent with the mode of the recorder/reproducer (and therefore could not be decoded).

However, it is submitted that it would have been clearly obvious (as evidenced by Hashimoto col. 11, ll. 17-35 and fig. 14a) to one of ordinary skill in the art at the time the invention was made to modify the combined teaching with the displaying of an alarm if an input or output that is inconsistent with the replay mode so as to notify the user of a problem that may arise in program recording or reproduction.

Akamatsu, Sparks, Hashimoto are unclear on the specific feature of
"a decoding capability circuit for determining whether a digital signal of the program recorded on the recording medium reproduced by said reproducing apparatus and received through said digital interface is decodable by said decoder."

However, Yuen inherently discloses the ability to determine whether a digital signal of the program recorded on the recording medium reproduced by said reproducing apparatus and received through said digital interface is decodable by said

decoder. *If the program is displayed on the display apparatus then it has been determined that the program is indeed decodable.*

As to claim 59, Akamatsu and Sparks and Hashimoto (as combined in claim 58) disclose an apparatus according to claim 58, wherein said information associated with said program includes at least one of a channel number of the program, a program name, a genre, a date of the recording, and a recording time (see Akamatsu, fig. 30).

As to claim 60, Akamatsu and Sparks and Hashimoto (as combined in claim 58) disclose an apparatus according to claim 58, wherein said information associated with said program includes recording position information of the program on the recording medium (see Akamatsu, fig. 30).

As to claim 63, Akamatsu discloses a receiving apparatus of a digital broadcasting for

receiving a digital broadcasting signal constructed by a transport stream in which video data and audio data have been compressed and multiplexed, comprising (see Akamatsu, fig. 1, the IRD represents a receiving app for a digital broadcast):

a decoder for decoding said received digital broadcasting signal (see Akamatsu, fig. 1, the IRD is a decoder of the signal);

a digital interface for receiving a transport stream from an external reproducing apparatus (fig. 1, recording device) having both analog and digital recording and

reproducing modes (see Akamatsu, fig. 4, the communication interface is a digital interface with an external reproducing apparatus with D/A record and play modes (see p. 21, ll. 20-25 and fig. 4 shows both a reproducing and recording section on the related device); and

Akamatsu is unclear on the digital broadcast signal is displayed; however, Sparks, who discloses OSD insertion, does teach this (see Sparks [0008] a dig. Signal source is coupled to display regardless of recorder's status).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Akamatsu with the apparatus of Sparks in order to allow for display of digital signals during digital record mode without adding extra complexity to the apparatus. Sparks teaches a display processing circuit for displaying (see Sparks, fig. 2, processing within 200);

Akamatsu, Sparks are unclear on the displaying of an alarm or message if the user selects an input/output that is inconsistent with the mode of the recorder/reproducer (and therefore could not be decoded).

However, it is submitted that it would have been clearly obvious (as evidenced by Hashimoto col. 11, ll. 17-35 and fig. 14a) to one of ordinary skill in the art at the time the invention was made to modify the combined teaching with the displaying of an alarm if an input or output that is inconsistent with the replay mode so as to notify the user of a problem that may arise in program recording or reproduction.

The Akamatsu, Sparks, Hashimoto are unclear on the specific feature of

"a decoding capability circuit for determining whether a digital signal of the program recorded on the recording medium reproduced by said reproducing apparatus and received through said digital interface is decodable by said decoder."

However, Yuen inherently discloses the ability to determine whether a digital signal of the program recorded on the recording medium reproduced by said reproducing apparatus and received through said digital interface is decodable by said decoder. *If the program is displayed on the display apparatus then it has been determined that the program is indeed decodable.*

As to claims 64 and 65, they are analyzed similar to claims 59 and 60, respectively.

As to claim 72, Akamatsu discloses a method of recording program associated information in a receiving apparatus of a digital broadcasting, comprising (see Akamatsu, fig. 1):

receiving a digital broadcasting signal constructed by a transport stream in which video data and audio data have been compressed and multiplexed, comprising (see Akamatsu, fig. 1, the IRD represents a receiving app for a digital broadcast):

a decoder for decoding said received digital broadcasting signal (see Akamatsu, fig. 1, the IRD is a decoder of the signal);

a digital interface for receiving a transport stream from an external reproducing apparatus (fig. 1, recording device) having both analog and digital recording and

reproducing modes (see Akamatsu, fig. 4, the communication interface is a digital interface with an external reproducing apparatus with D/A record and play modes (see p. 21, ll. 20-25 and fig. 4 shows both a reproducing and recording section on the related device); and

Akamatsu is unclear on the digital broadcast signal is displayed; however, Sparks, who discloses OSD insertion, does teach this (see Sparks [0008] a dig. Signal source is coupled to display regardless of recorder's status).

Sparks teaches a display processing circuit for displaying (see Sparks, fig. 2, processing within 200, the information displayed is certainly associated with the program recorded (and shown in a predetermined format-display));

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Akamatsu with the apparatus of Sparks in order to allow for display of digital signals during digital record mode without adding extra complexity to the apparatus.

Akamatsu, Sparks are unclear on the displaying of an alarm or message if the user selects an input/output that is inconsistent with the mode of the recorder/reproducer (and therefore could not be decoded).

However, it is submitted that it would have been clearly obvious (as evidenced by Hashimoto col. 11, ll. 17-35 and fig. 14a) to one of ordinary skill in the art at the time the invention was made to modify the combined teaching with the displaying of an alarm if an input or output that is inconsistent with the replay mode so as to notify the user of a problem that may arise in program recording or reproduction.

Akamatsu, Sparks, Hashimoto are unclear on the specific features of
“a CPU programmed for retrieving information associated with a program
recorded on a recording medium loaded in said reproducing apparatus from a memory
in said reproducing apparatus” and

“a decoding capability circuit for determining whether a digital signal of the
program recorded on the recording medium reproduced by said reproducing apparatus
and received through said digital interface is decodable by said decoder.”

However, Yuen discloses a CPU programmed for retrieving information
associated (titles) with a program recorded (figs. 18-19) on a recording medium loaded
in said reproducing apparatus from a memory in said reproducing apparatus (see figs
18-19 for a list of recorded programs).

Yuen also inherently discloses the ability to determine whether a digital signal of
the program recorded on the recording medium reproduced by said reproducing
apparatus and received through said digital interface is decodable by said decoder. *If
the program is displayed on the display apparatus then it has been determined that the
program is indeed decodable.*

5. Claims 61 and 66, are rejected under 35 U.S.C. 103(a) as being obvious over
Akamatsu et al. (US 7224886) and Sparks et al. (US 2002/0018638) and further in
further view of Hashimoto et al. (US 5990940), and further in view of Yuen (US
5621579), and further in further view Yuen et al. (US 6147715).

As to claim 61, Akamatsu and Sparks and Hashimoto (as combined) disclose an apparatus according to claim 58,

Akamatsu, Sparks, Hashimoto are unclear on wherein said information associated with said program is overlapped to a reproduction signal from said reproducing apparatus and displayed, however, Yuen '715, who discloses an apparatus for indexing guide information for recordation and replay, teaches information associated with a program that is "overlapped" or overlaid to a reproduction signal so as to provide the user with information in a convenient fashion (see Yuen '715, col. 1, ll. 59-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of the combination with that of Yuen so as to provide the user with information in a convenient fashion (see Yuen '715, col. 1, l. 50-col. 2, l. 4).

As to claim 66, it is analyzed similar to claim 61.

6. Claims 62 and 67, are rejected under 35 U.S.C. 103(a) as being obvious over Akamatsu et al. (US 7224886) and Sparks et al. (US 2002/0018638), and further in further view of Hashimoto et al. (US 5990940), and further in view of Yuen (US 5621579), and further in view Yuen et al. (US 6147715) in further view of Suga et al (US 2004/0208482).

As to claim 62, Akamatsu and Sparks and Hashimoto (as combined) disclose an apparatus according to claim 58,

Akamatsu, Sparks, Hashimoto are unclear on wherein said information associated with said program is overlapped to a reproduction signal from said reproducing apparatus and displayed, however, Yuen, who discloses an apparatus for indexing guide information for recordation and replay, teaches information associated with a program that is "overlapped" or overlaid to a reproduction signal so as to provide the user with information in a convenient fashion (see Yuen, col. 1, ll. 59-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of the combination with that of Yuen so as to provide the user with information in a convenient fashion (see Yuen, col. 1, l. 50-col. 2, l. 4).

Akamatsu, Sparks, Hashimoto, Yuen '579, with Yuen '715 is unclear on displaying information of the mode of the recorded program, however, Suga, who discloses an apparatus for indexing guide information for recordation and replay, does teach displaying information of the mode of the recorded program (see Suga, fig. 5 and 29-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of the Yuen combination with Suga in order to display record mode information for a user (see Suga, [174-179]).

As to claim 67, it is analyzed similar to claim 62.

Response to Arguments

7. Applicant's arguments with respect to claims 52, 58-67, and 72 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the applied portions of Hashimoto appear to concern adjustments on a video monitor for an input video signal, and displaying an error message if scanning frequencies of the input video signal are out of the adjustable range of the monitor or if no video signal is present. In contrast to the claimed invention, Hashimoto is not concerned with, and does not disclose, determining whether a reproduced digital signal of a program recorded on a recording medium "is decodable" at a receiving apparatus which receives the reproduced digital signal, and does not disclose notifying a user, with a message on a display, that the digital signal of the program recorded on the recording medium cannot be decoded.

In response to Applicant's invention, newly cited art Yuen is now relied upon for teaching the determining step of whether or not a program recorded may be decoded (or displayed). Hashimoto is relied upon to teach the error message or alarm message for display to the user in the event that a program is unable to be decoded (or displayed). In combination, these two references would allow a program to either be displayed (or decoded) or have an error message be displayed.

Conclusion

8. Claims 52, 58-67, 72 are rejected.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUSHFIKH ALAM whose telephone number is (571)270-1710. The examiner can normally be reached on Mon-Fri: 8:30-18:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hirl Joseph can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mushfikh Alam/

Application/Control Number: 09/600,003

Page 16

Art Unit: 2426

Examiner, Art Unit 2426

6/12/2009

/Joseph P. Hirl/

Supervisory Patent Examiner, Art Unit 2426

June 16, 2009